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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,288	03/12/2004	Michael T. Costello	0178-PA	8266
7590 Michael P. Dilworth Crompton Corporation Benson Road Middlebury, CT 06749			EXAMINER GOLOBOY, JAMES C	
			ART UNIT	PAPER NUMBER
			1714	
			MAIL DATE	DELIVERY MODE
			07/03/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/800,288	<b>Applicant(s)</b> COSTELLO ET AL.	
	<b>Examiner</b> James Goloboy	<b>Art Unit</b> 1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-5, 8, 10-16, 19 and 21-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8, 10-16, 19, 21-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. Claims 1-3, 10, 12-14, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Csikos (GB Pat. App. No. 2,193,972 A) in view of Emert (U.S. Pat. No. 5,498,809) and Bennett (U.S. Pat. No. 4,925,582).

This rejection is adequately set forth in paragraph 3 of the office action mailed 4/5/07.

2. Claims 4-5 and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Csikos in view of Emert and Bennett as applied to claims 1-3, 10, 12-14, and 21 above, and further in view of Crompton Corporation ([http://www.cromptoncorp.com/servlet/ContentServer?pagename=Crompton/ck\\_article/pressrelease&c=ck\\_article&cid=1042056763595&type=whatsnew](http://www.cromptoncorp.com/servlet/ContentServer?pagename=Crompton/ck_article/pressrelease&c=ck_article&cid=1042056763595&type=whatsnew) and [http://www.cromptoncorp.com/servlet/ContentServer?pagename=ck/pressrelease&c=ck\\_article&cid=1003866980424&p=984583117820&type=whatsnew](http://www.cromptoncorp.com/servlet/ContentServer?pagename=ck/pressrelease&c=ck_article&cid=1003866980424&p=984583117820&type=whatsnew)).

This rejection is adequately set forth in paragraph 4 of the office action mailed 4/5/07.

3. Claims 4 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Csikos, Emert, and Bennett as applied to claims 1-3, 10, 12-14, and 21 above, and further in view of Calabrese (U.S. Pat. No. 6,348,514).

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This rejection is adequately set forth in paragraph 5 of the office action mailed 4/5/07.

4. Claims 8 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Csikos, Emert, and Bennett as applied to claims 1-3, 10, 12-14, and 21 above, and further in view of Yamazaki (U.S. Pat. No. 6,075,065).

This rejection is adequately set forth in paragraph 6 of the office action mailed 4/5/07.

5. Claims 8 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Csikos, Emert, and Bennett as applied to claims 1-3, 10, 12-14, and 21 above, and further in view of McEntee (U.S. Pat. No. 4,624,679).

This rejection is adequately set forth in paragraph 7 of the office action mailed 4/5/07.

6. Claims 1-3, 10-14, and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Csikos in view of Emert and Fields (U.S. Pat. No. 5,981,632).

This rejection is adequately set forth in paragraph 8 of the office action mailed 4/5/07.

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7. Claims 23-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Csikos in view of Emert and Fields as applied to claims 1-3, 10-14, and 21-22 above, and further in view of Crompton Corporation.

This rejection is adequately set forth in paragraph 9 of the office action mailed 4/5/07.

8. Claims 23-25 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Csikos in view of Emert and Fields as applied to claims 1-3, 10-14, and 21-22 above, and further in view of Calabrese.

This rejection is adequately set forth in paragraph 10 of the office action mailed 4/5/07.

9. Claims 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Csikos in view of Emert and Fields as applied to claims 1-3, 10-14, and 21-22 above, and further in view of Yamazaki.

This rejection is adequately set forth in paragraph 11 of the office action mailed 4/5/07.

10. Claims 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Csikos in view of Emert and Fields as applied to claims 1-3, 10-14, and 21-22 above, and further in view of McEntee.

This rejection is adequately set forth in paragraph 12 of the office action mailed 4/5/07.

### ***Response to Arguments***

11. The claims have been amended to require that the antioxidant and biocide be added to a prelube metalworking fluid. However, this new limitation does not appear to structurally distinguish the claims over the prior art. On pages 17-18 of the remarks filed 5/17/07, applicant argues that prelube metalworking fluids require oxidation stability and resistance to microorganisms; the compositions resulting from the obvious combinations of prior art in the rejections set forth above possess these same qualities.

Applicant additionally reiterates their arguments of 1/22/07 regarding the allegedly synergistic effects between the claimed antioxidants and biocides, and the optional nature of the antioxidant of Csikos. Regarding those arguments, the examiner maintains the positions expressed in the final rejection mailed 4/5/07.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Goloboy whose telephone number is 571-272-2476. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Vasu Jagannathan/  
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